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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

HOWARD, SHARON LEE

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 02/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/582,825

Applicant(s)

CARRION ET AL.

Examiner

Sharon L. Howard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/7/02, 9/4/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Examiner acknowledges receipt of two months request for extension of time, prior art with attachment and request under 1.114 filed on 8/7/02 and response with attachment filed on 9/4/02.

Claims 1-24 are pending.

Specification

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

DETAILED ACTION

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pappas et al. (U.S. Patent No. 5,093,108) in view of Kallenbach (U.S. Patent No. 5,212,214)..

Pappas teaches a quick drying nail enamel composition and a method for coating a surface (see abstract). Pappas teaches primary film forming polymers (e.g. nitrocellulose, cellulose acetate, ethyl cellulose, vinyl polymers, acrylate type polymers and a secondary, additional film forming polymers comprising alkyd resins and acrylic and methacrylic resins (col.9, lines 13-68) which are known for providing an adhesion

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and an effective gloss, a plasticizer (col.10, lines 1-33), a thixotropic agent and pigments (col.12, lines 65-68). Pappas teaches that the compositions are known to dry to a hard coating, and for exhibiting high gloss and durability.

Pappas does not teach microspheres.

However, Kallenbach discloses a coating composition which is known for enhancing hardness and durability. Kallenbach teaches that the coating composition can be applied to a substrate (see abstract). Kallenbach teaches ceramic microsphere, which is made of hollow-spherically-shaped ceramic particles (col.7, lines 63-68 and col.8, lines 1-8), as well as EXTENDOSPHERES and ZEEOSPHERES (col.8, lines 13-36), and the teaching of the particle size distribution and the diameter of the microspheres are encompassed therein. Kallenbach teaches that the ceramic microsphere filler have a particle size of less than 325 mesh (col.8, lines 2 and 3).

Both references teach a composition which are known for enhancing hardness of a coating composition. It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. **(See In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980)).**

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Pappas and Kallenbach. One having ordinary skill in the art would have been motivated to prepare a third composition by including microspheres into the composition of Pappas, because the third composition can be used for the same purpose of coating a substrate or fingernails.

The expected result would be a composition comprising microspheres which is known for coating the nails.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Response to Arguments

Applicant's arguments filed 9/4/02 have been fully considered but they are not persuasive. Applicant argues that there would be no motivation to use Kallenbach's composition on the human nails taught as substrates in Pappas.

In response to applicant's argument, there is a motivation to use Kallenbach's composition with Pappas. Kallenbach and Pappas both teach a coating composition. The microspheres taught by Kallenbach are well known as a coating ingredient and the argument against the high temperature curing of Kallenbach is not persuasive since the claims are directed to coating compositions and a method of application. In essence, there is no requirement for a subsequent heat curing in the process step, nor is it a requirement that the nail coating be limited to human nails.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Howard whose telephone number is (703) 308-4359. The examiner can normally be reached on 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-3121 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Sharon Howard
February 8, 2003

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
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